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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/052,582

01/18/2002

Glen A. Evans

P-EA 5160

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06/28/2004

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EXAMINER

SMITH, CAROLYN L

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/052,582

Applicant(s)

EVANS, GLEN A.

Examiner

Carolyn L Smith

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-52 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

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Detailed Action

Restriction/Election

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-14 and 38, drawn to a method of synthesizing a target polynucleotide comprising identifying three polynucleotide sequences and contacting the initiating polynucleotide with the second and third polynucleotides, classified in class 706, subclass 13 and class 536, subclass 25.3.
- II. Claims 15-19 and 38, drawn to a method for synthesizing a target polynucleotide comprising identifying, contacting and catalyzing for primer extension steps, classified in class 702, subclass 19 and class 536, subclass 25.3.
- III. Claims 20-27 and 38, drawn to a method of synthesizing a target polynucleotide comprising identifying and contacting two polynucleotide sequences, classified in class 536, subclass 25.3.
- IV. Claims 28-37, drawn to a method for isolating a target polypeptide, classified in class 530, subclass 412.
- V. Claims 39-40, drawn to a method for synthesizing a target polynucleotide via chemically synthesizing a plurality of oligonucleotides, classified in class 536, subclass 25.3.
- VI. Claims 41-44, drawn to a computer program for generating a target polynucleotide sequence, classified in class 702, subclass 19 and class 211, subclass 41.12.
- VII. Claims 45-46, drawn to a computer-assisted method for synthesizing a target polynucleotide via inputting, determining, selecting, and outputting data, classified in class 700, subclass 29.

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- VIII. Claims 47-50, drawn to a method for automated synthesis of a target polynucleotide sequence via user interactions, classified in class 702, subclass 20.
- IX. Claims 51-52, drawn to an isolated polynucleotide composition, classified in class 536, subclass 23.1.

Inventions in Groups I-IX are related as product and the process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polynucleotide composition of Group IX may be utilized in distinct usages as needed in Group I for a method of synthesizing a target polynucleotide comprising identifying three polynucleotide sequences and contacting the initiating polynucleotide with the second and third polynucleotides, in a method for synthesizing a target polynucleotide comprising identifying, contacting and catalyzing for primer extension steps as in Group II, in a method of synthesizing a target polynucleotide comprising identifying and contacting two polynucleotide sequences as in Group III, in a method for isolating a target polypeptide as in Group IV, in a method for synthesizing a target polynucleotide via chemically synthesizing a plurality of oligonucleotides as in Group V, in a computer program for generating a target polynucleotide sequence as in Group VI, in a computer-assisted method for synthesizing a target polynucleotide via inputting, determining, selecting, and outputting data as in Group VII, in a method for automated synthesis of a target polynucleotide sequence via user interactions as

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in Group VIII, or alternatively, in preparing T cells. All of these usages are distinct as requiring distinct and different functions thereof without overlapping search due to different subject matter. This lack of overlapping searches documents the undue search burden if they were searched together.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement may be traversed (37 CFR 1.143).

Claim 38 link(s) inventions I, II, and III. The restriction requirement states the linked inventions is subject to the nonallowance of the linking claim(s), claim 38. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

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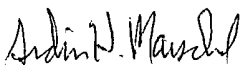
Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR §1.6(d)). The CM1 Fax Center number is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Smith, whose telephone number is (571) 272-0721. The examiner can normally be reached Monday through Thursday from 8 A.M. to 6:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (571) 272-0722.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instruments Examiner Tina Plunkett whose telephone number is (571) 272-0549.

June 21, 2004


ARDIN H. MARSCHEL 6/22/04
PRIMARY EXAMINER